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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,794	05/21/2001	Yajnanarayana Halmuthur Jois	TH-1917 (US)	8992

7590 01/16/2003

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[REDACTED] EXAMINER

ARNOLD JR., JAMES

ART UNIT	PAPER NUMBER
1764	4

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)
09/862,794	JOIS ET AL.
Examiner	Art Unit
James Arnold, Jr.	1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 21 May 2001.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)                  4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                  5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2                  6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, is unclear what ratio proportion is intended by the range 1-99%. For example, it is not apparent if applicant means to say that "the proportion of said extract component to said distillate in said pre-blend is in the range of 1:99-99:1" or if the applicant purports to convey a different meaning. Appropriate clarification and/or correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreno (EP-0 839 891) in view of George A. Olah, Hydrocarbon Chemistry (pages 35-36).

The Moreno reference discloses a process for producing a non-toxic aromatic oil having less than one mutogenicity index. See page 17, lines 35-40. Moreno discloses the use of an extract from a feed plant and a distillate. See page 4, lines 31-32 and page 21, lines 28. The Moreno reference discloses a process whereby the extract is selected from the group consisting of different cuts of extracts of a lube plant. See page 21, line 28. The Moreno reference discloses a process whereby the distillate is selected from the group consisting of different cuts of distillate of a vacuum distillation unit. See page 4, line 29.

The Moreno reference does not disclose a process whereby the extract from a lube plant and a distillate are pre-blended in a feed tank. The reference does not disclose hydrotreating the pre-blend feed. The reference does not disclose mixing a suitable grade, calculated amount of an extract stream to a distillate stream of desired properties; a process wherein the proportion of said extract component to said distillate in said pre-blend is in the range of 1-99%; or a process wherein the proportion of the extract component in the pre-blend is in the range of 1-50%. The reference does not disclose a process wherein the hydrogenation of the feed uses an appropriate hydrotreating catalyst selected from the group consisting of Nickel-Molybdenum and Nickel-Cobalt.

The Olah reference discloses hydrotreating of oil and discloses the use of Nickel-Molybdenum and Nickel-Cobalt as hydrotreating catalysts. See pages 35-36.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a process whereby the extract from a lube plant and a distillate are pre-blended in a feed tank because distillate is used to make and is a component of extract flow obtained in the manufacture of lubricant base oils. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a process whereby a suitable grade, calculated amount of an extract stream is mixed to a distillate stream of desired properties; a process wherein the proportion of said extract component to said distillate in said pre-blend is in the range of 1-99%; or a process wherein the proportion of the extract component in the pre-blend is in the range of 1-50% because since both the distillate and the extract are necessary for making non-carcinogenic aromatic oil it would be proper to combine them in any ratio effective for producing such oil. It would have been obvious to one having ordinary skill in the art at the time the invention was made to hydrotreat the pre-blend feed because hydrotreating can be used in processing feeds with high aromatic content. See Olah pages 35-36. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize Nickel-Molybdenum and Nickel-Cobalt as hydrotreating catalysts because these are commonly used as hydrotreating catalysts. See Olah, pages 35-36.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreno (EP-0 839 891) in view of George A. Olah, Hydrocarbon Chemistry (pages 35-36) as applied to claim above, and further in view of Cash (USPN 6,224,747).

The Cash reference discloses hydrotreating conditions in the range of about 482 F-932 F and pressure in the range of 500 psi to 3,500 psi. See Column 7, lines 50-55.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize these conditions because these are standard hydrotreating conditions and hydrotreating is a necessary part of the process of producing non-carcinogenic, high aromatic oil.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Arnold, Jr. whose telephone number is 703-305-5308. The examiner can normally be reached on Monday-Thursday 8:30 AM-6:00 PM; Fridays from 8:30 AM-5:00 PM with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Calderola can be reached on 703-308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

ja  
January 12, 2003

*Walter D. Griffin*  
**Walter D. Griffin**  
**Primary Examiner**